

ESTTA Tracking number: **ESTTA463801**

Filing date: **03/26/2012**

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE  
BEFORE THE TRADEMARK TRIAL AND APPEAL BOARD

Proceeding	91202732
Party	Plaintiff EcoWater Systems LLC
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Date	03/26/2012
Attachments	2012.03.26 EcoWater Answer to Counterclaim.pdf ( 5 pages )(140996 bytes )

**IN THE UNITED STATES PATENT AND TRADEMARK OFFICE  
BEFORE THE TRADEMARK TRIAL AND APPEAL BOARD**

<b>ECOWATER SYSTEMS LLC,</b>	)	
	)	
Opposer,	)	
	)	Opposition No.: 91202732
v.	)	
	)	Mark: ECOLAB
<b>ECOLAB USA INC.,</b>	)	
	)	
Applicant/Counterclaimant.	)	

**ECOWATER SYSTEMS LLC’S ANSWER TO  
COUNTERCLAIM PETITION TO CANCEL**

Opposer, EcoWater Systems LLC (“Opposer”), for its Answer to Ecolab USA Inc.’s (“Applicant”) Counterclaim Petition to Cancel states as follows:

1. Admitted.
2. Opposer is without knowledge or information sufficient to form a belief as to the truth of the allegations in Paragraph 2 and therefore denies same.
3. Opposer is without knowledge or information sufficient to form a belief as to the truth of the allegations that Petitioner’s ECOLAB mark has been extensively and continuously used in a advertising and promotional materials, and in other ways customary in the trade, to promote water filtration and water treatment products throughout the United States, as stated in Paragraph 3, and therefore denies same. Opposer denies all other allegations in Paragraph 3.
4. Opposer admits that the U.S. Patent & Trademark Office records available through the [www.uspto.gov](http://www.uspto.gov) website indicate that, on July 28, 2010, application Serial No. 85/094,582 was filed in the name of Ecolab USA Inc. Opposer denies that said application covers “water filtration products” or “water treatment products.” Opposer is without knowledge or information sufficient to form a belief as to the truth of any and all other allegations in Paragraph 4.
5. Admitted.
6. Admitted.

7. Admitted.

8. Denied. Applicant is seeking to cancel Opposer's U.S. Reg. No. 3,268,985 for the "ECO PURE & Design" mark based, in part, on the similarity between the "ECOLAB" and "ECO PURE" terms and Applicant's alleged priority. However, Opposer owns U.S. Reg. No. 1,585,509 for the "ECO PURE" word mark filed on July 31, 1989 and registered on March 6, 1990. Opposer's rights in "ECO PURE" predate Applicant's rights in the "ECOLAB" mark. Accordingly, Applicant cannot show priority or standing for the cancellation of Opposer's U.S. Reg. No. 3,268,985.

9. Admitted.

10. Admitted.

11. Admitted.

12. Admitted.

13. Denied.

14. Opposer is without knowledge or information sufficient to form a belief as to the truth of the allegations in Paragraph 14 and therefore denies same.

15. Denied.

16. Denied.

17. Denied.

18. Denied.

### **AFFIRMATIVE DEFENSES**

1. Prior Registration: Applicant is seeking to cancel Opposer's Reg. No. 3,268,985 for the "ECO PURE & Design" mark based on the allegation that, if the "ECOLAB" and "ECO PURE" marks are found to be confusingly similar, Applicant would have priority based on Applicant's use of the "ECOLAB" mark with "water filtration and water treatment products since at least as early as the mid-1990s." Applicant is incorrect for a number of reasons and, in

particular, because Opposer owns a prior registration, namely, U.S. Reg. No. 1,585,509 for the “ECO PURE” mark covering “water purification and filtration units for domestic and commercial use.” The application for U.S. Reg. No. 1,585,509 was filed on July 31, 1989, long before Applicant’s alleged first use of “ECOLAB”. Thus, Applicant cannot show priority or standing, and Applicant cannot succeed on its petition to cancel Reg. No. 3,268,985 for the “ECO PURE & Design” mark.

2. Family of Marks: Even though Opposer’s application for the “ECO PURE & Design” mark was filed after Applicant’s application for the “ECOLAB” mark, Opposer can rely on the priority of Opposer’s entire “family” of “ECO” marks, the priority which dates back to at least as early as October 12, 1976 when Opposer filed its application for the “ECODEX” and “ECOCOTE” trademarks.

3. Laches: Reg. No. 1,710,954 registered on September 1, 1992, more than nineteen years ago, and Reg. No. 3,268,985 registered on July 24, 2007, more than four years ago. Applicant had constructive notice, and possibly active notice, of these registrations but did not raise any objection for years, and thus is barred by the defense of laches from seeking to cancel the registrations now.

4. Acquiescence: As stated above, Applicant has had constructive notice, and possibly active notice, of Reg. No. 1,710,954 and Reg. No. 3,268,985 but did not raise any objection to the registrations for years. Opposer relied in part on the lack of any objection by Applicant or any other party in maintaining the registrations for the “ECO PURE & Design” and “ECOSORB” marks, and Applicant is thus estopped from seeking to cancel the registration now.

5. Failure to State a Claim: Applicant has failed to state a claim upon which relief can be granted for the cancellation of Reg. No. 3,268,985 for the "ECO PURE & Design" mark in light of Opposer's priority in the term "ECO PURE".

Dated: March 26, 2012

Respectfully submitted,

**ECOWATER SYSTEMS LLC**

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**CERTIFICATE OF ELECTRONIC FILING AND SERVICE**

I hereby certify that “EcoWater Systems LLC’s Answer to Counterclaim Petition to Cancel” was filed electronically with the Trademark Trial & Appeal Board on the date indicated below, and that a copy was served on Ecolab USA Inc. on the date indicated below, via U.S. First Class Mail, in an envelope addressed as follows:

Dean R. Karau  
Lora Friedemann  
Laura Myers  
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*Caroline Stevens*

Signature

March 26, 2012

Date